

II. REMARKS

Claims 1-21 are pending in the present application. In the office action dated 01/25/2008, the prior information disclosure statement, entered on 01/17/2008, was not considered by the Examiner because the date of publication for the cited reference could not be determined. In the office action, the drawings were objected to because Figure 4 contained shading that made the figure difficult to read. In the office action, claims 1-17 were objected to because of improper line spacing. Further, claims 1-15 were objected to because the Examiner believes the phrase “license rights package” should contain further specificity. In the office action, claims 1-17 were rejected under 35 USC § 102(e) as being anticipated by US 7,133,846 (Ginter). Finally, in the office action, the Examiner stated that claims 16 and 17 contained optional language that must be positively recited before being given patentable weight. Each of these items will be discussed in turn.

*A. Telephonic Interview*

Before discussing the substance of the office action, Applicants would like to thank the Examiner for the courtesies extended in the interview conducted by telephone on April 10, 2008. While no specific agreement was reached, Applicants thank the Examiner for suggesting language to overcome claim objections. Also Applicants thank the Examiner for his general comments directed to preferred computer-related claim formats.

*B. Information Disclosure Statement*

Applicants respectfully submit that the information disclosure statement entered on 01/17/2008 indicates a publication date of 09/06/2007 for the disclosed reference—an office action issued by the USPTO for Serial No. 10/874,712. This publication date is shown on the information disclosure statement form and the reference attached thereto. Applicants respectfully submit that the previously entered information disclosure statement is in proper form and should be considered by the Examiner. Applicants further submit that such disclosure of the rejections made in a related co-pending application are proper according to MPEP 2001.06(b) (citing Dayco Prod., Inc. v. Total Containment, Inc., 329 F.3d 1358, 1365-69 (Fed. Cir. 2003)).

### *C. Drawing Objections*

Applicants have attached an amended drawing for Figure 4. Applicants respectfully submit that the amended drawing overcomes the objection and the drawings, as amended, should be accepted by the Examiner. Furthermore, the drawing contains no new matter and is merely a clean version, without shading, of the original drawing.

### *D. Claim Objections*

The claims have been amended to include the proper line spacing as requested by the Examiner. Applicants respectfully submit that the amended claims overcome the objection for improper line spacing.

The claims have been amended to clarify the license rights package in regards to the debiting of the license rights package. Applicants respectfully submit that the amended claims overcome the Examiner's objection. These amendments are supported by the original specification, drawings, and claims. *See e.g.*, Paragraphs [0064] and [0122].

### *E. Claim Rejections Under 35 USC § 102(e)*

Applicants note that taken singularly, the art of record fails to disclose all of the limitations recited in each present independent claim. Therefore, Applicants submit that the rejection under 35 USC § 102(e) should be withdrawn.

#### 1. Legal Standard for Anticipation

Under MPEP 2131, a claim is anticipated only if *each and every element* as set forth in the claim is found, either expressly or inherently described, in a *single* prior art reference. The identical invention must be shown in as complete detail as is contained in the claim. In addition, the elements in the prior art reference *must be arranged as required by the claim*. MPEP 2131 (emphasis added).

#### 2. Independent Claims 1, 16, 18, 21 and Dependents Therefrom

Applicants submit that each present independent claim contains limitations not expressly or inherently described in any single prior art reference of record. For example, Ginter fails to

teach a rating engine that allows for modifying the license rights package when the media device is not connected to the host system, and storing a charge for the modifications for selective transmission to a host system. Independent claims 1, 16, 18, and 21 each require this element, among others. Any amendments made to include these elements are supported by the original specification, drawings, and claims. *See e.g.*, [0064], [0072], and [0082]-[0083].

With respect to the rating engine, the office action stated that Ginter teaches a rating engine as evidenced by Column 75, lines 9-19, element 450. However, element 450 of Ginter is a “rights template” used to help rightsholders establish “control sets.” These control sets are analogous to rights permissions, and the rights templates simplify the process for rightsholders to decide on permission schemes and associate such permission schemes with the rightsholders’ content. According to Ginter, “Rights template 450 may be analogous in some respects to ‘fill in the blank’ forms. Rights holders can use rights templates 450 to efficiently and effectively define the rights associated with a particular digital property.” *See* Column 74, lines 22-25.

The rights templates of Ginter are not equivalent to the rating engine in the present application. As discussed in the present application’s specification and claims, the rating engine provides the novel and nonobvious ability to modify a license rights package when not connected to a host system. As the example in the present application states, a child may have a media device containing a particular gaming software and a license rights package that allows the child to access this gaming content. In this example, the child is traveling with his family by car when he exhausts his license rights to access the gaming content. In this example, the rating engine capability allows the license rights to be renewed so that the child can continue to access the gaming content despite not having connectivity to a host system. *See* Paragraph [0082]. The rights templates of Ginter, by contrast, are mere permission forms which allow the rights clearinghouse to create and store permissions for content based on preferences of the rightsholders. Such rights templates themselves are not used by the electronic appliance, but rather the permissions created from the rights templates are sent to electronic appliances when use of these permissions are requested. At such time, the user’s account is charged and the permissions sent to the electronic appliance thereby releasing the content. *See* Ginter Column 29, lines 1-6. The model of rights management disclosed by Ginter is clearly analogous to a

traditional pay-as-you-go structure. The mere disclosure of a traditional pay-as-you-go structure is not equivalent to disclosing a rating engine that allows for a novel and nonobvious way to overcome the problem of managing digital rights at times when connectivity to a host system does not exist.

Based on the forgoing, Applicants submit that no single prior art reference of record contains each and every element as set forth in present independent claims 1, 16, 18, and 21 according to MPEP 2131. Furthermore, the prior art of record fails to teach or suggest a rating engine as claimed in the present application. Accordingly, Applicants respectfully submit that the prior art of record fails to anticipate, or render obvious, the present claims. Also, where an independent claim is not anticipated or obvious, claims depending from the independent claim are not anticipated or obvious. Therefore, Applicants respectfully requests that the rejection be withdrawn.

#### *F. Claim Interpretation*

As mentioned above, the Examiner stated that certain language used in claims 16 and 17 was considered optional language and must be recited positively to be given patentable weight. Applicants respectfully disagree with the Examiner's assessment in this regard.

According to MPEP 2106, "Language that suggests or makes optional but does not require steps to be performed or does not limit a claim to a particular structure does not limit the scope of a claim or claim limitation." However, the MPEP is clear that the use of specific terms alone does not automatically mean that the language imparts an optional characteristic to the claim limitations. *See* MPEP 2111.04, stating with respect to specific clauses that "[t]he determination of whether each of these clauses is a limitation in a claim depends on the specific facts of the case." As an example identified in MPEP 2111.04, in the context of a clause preceded by the term "whereby," the Federal Circuit has held that when a "'whereby' clause states a condition that is material to patentability, it cannot be ignored in order to change the substance of the invention." *Hoffer v. Microsoft Corp.*, 405 F.3d 1326, 1329, 74 USPQ2d 1481, 1483 (Fed. Cir. 2005). In contrast, a "whereby" clause that merely states an intended result of a recited claim step is not accorded patentable weight. *Id.* (quoting *Minton v. Nat'l Ass'n of*

Securities Dealers, Inc., 336 F.3d 1373, 1381, 67 USPQ2d 1614, 1620 (Fed. Cir. 2003)). Therefore, in reviewing alleged optional claim language, an Examiner must consider the context of the claim and determine if the alleged optional claim language does more than states an intended result, and instead states a condition material to patentability.

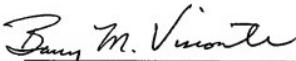
Considering claims 16 and 17, these claims do not include optional language when properly interpreted. Instead these claims clarify a condition precedent to a required claim limitation. In this context, these conditions and their associated claim limitations are material to patentability and do more than merely state an intended result of a recited claim step. As such, Applicants respectfully note that these claims should not be interpreted as having optional limitations that can be ignored.

III. CONCLUSION

While several distinctions have been noted over the art of record, Applicants note that there are several other limitations recited in the present claims which are not considered by the art of record. Applicants expressly reserve all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Applicants further note that the dependent claims include additional limitations not considered in the art of record, thus forming further independent bases for novelty and nonobviousness.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicants respectfully request reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or remarks made herein, Applicants invite the Examiner to contact the undersigned via telephone at (513) 651-6849 or via e-mail at bvisconte@fbtlaw.com.

Respectfully Submitted,



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